

REMARKS/ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks.

II. Disposition of Claims

Claims 23-25, and 27-44 are pending in this application. In this Response, claim 24 has been amended and claims 23, 25, 27-32, 35-36, and 40-44 have been canceled.

III. Claim Objections

The Examiner has objected to claims 35 and 36 under 37 CFR 1.75(c). Applicants have canceled these claims, rendering these objections moot.

IV. Claim Rejections—35 U.S.C. § 112

The Examiner has rejected claims 24 and 33-39 under 35 U.S.C. § 112, second paragraph, as lacking insufficient antecedent basis for the limitation “the blend” in the claims. Applicants have amended claim 24 as suggested by the Examiner. Applicants have canceled claims 35 and 36 rendering the rejections as to these claims moot. Claims 33-34 and 37-39 depend from amended claim 24.

V. Double Patenting—Obviousness Type

The Examiner has provisionally rejected claims 24 and 33-39 as unpatentable over claims in copending Application Nos. 10/933,560, 11/633,703, 11/633,704, and 11/634,008. Terminal disclaimers for each are submitted herewith.

VI. Claim Rejections—35 USC § 102

The Examiner has maintained his rejection of all pending claims 24, 26, and 33-39 as anticipated by U.S. Patent No. 5,691,281 to Ashjian. Specifically, the Examiner has stated that:

Ashjan teaches a method of drilling a wellbore comprising circulating a drilling mud comprising an invert emulsion (Column 1 Lines 5-65) comprising a base composed of a blend of 5 to 80 weight percent (Column 6 Lines 23-27) of a long chain isomerized olefin of at least 18 carbon atoms (Column 3 Lines 26-41) and 50 to 90 weight percent of n-paraffins, iso-paraffins and cycloparaffins of 10 to 18 carbon atoms (Column 3 Lines 51-59 and Column 6 Line 38-Column 7 Line 6) which may further comprise esters (Column 6 Lines 28-37) which, by difference, may comprise up to 45 weight percent of the blend.

In traversing these rejections, Applicants have further amended independent claim 24 to still further distinguish and define their invention.

The law is well established that for anticipation under Section 102, the Examiner must find “identity of invention.” That is, the claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order for the reference to anticipate. *Eg., Glaverbel Société Anonyme v. Northlake Marketing & Supply Inc.*, 45 F.3d 1550, 33 U.S.P.Q.2d 1496, 1498 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566, 1567, 1568 (Fed. Cir. 1990)(every element of the claimed invention must be identically shown in a single reference and these elements must be arranged as in the claims under review). The prior-art embodiments “must possess the properties expressly recited in the claims.” *Eg., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988). “When a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate.” *Mendenhall v. Astec Industries, Inc.*, 13 U.S.P.Q.2d 1913, 1928 (Tenn. 1988), *aff’d*, 13 U.S.P.Q.2d 1956 (Fed. Cir. 1989), citing *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d. 1471, 1480, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986); *accord, Daiichi Pharmaceutical Co. v. Apotex, Inc.*, 441 F. Supp. 2d 672, 684-685 (D.N.J. 2006)(“Anticipation is not established if it is necessary to pick, choose and combine various portions of the disclosure not directly related to each other by the teachings of the reference in

order to show that the claims of the patent at issue are identically disclosed in the prior art.”), citing *In re Arkley*, 455 F.2d 586, 587-88 (C.C.P.A. 1972).

Applicants respectfully submit that the Ashjian reference fails to have identity of invention with Applicants claims. The word “ester” appears only once in the entire Ashjian reference, in the context as follows, from Col 6, lines 28-33:

Although various combinations of hydrocarbons and other materials such as esters may be used, blends of the olefin isomers with (i) a light paraffinic oil with essentially no aromatic content and (ii) an olefin component, will normally give good blend viscometrics, flash point, bioacceptability as well as favorable product economics. In blends of this type, the mineral oil component is a mixture of C.sub.10 -C.sub.18 n-paraffins and C.sub.10 -C.sub.32 olefins of low viscosity suitable for formulation into the well fluids after the addition of the olefin isomer component.

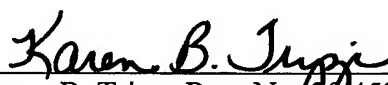
It is not entirely clear what the “hydrocarbons” are that are being referenced in the first line quote above, but it is believed from context that they are olefin isomers. Thus, the one time, one word reference to “esters” in the Ashjian reference appears to be indicating that olefin isomers may be mixed with esters but that a mixture of the olefin isomers with a light paraffinic oil and an olefin component would “give good blend viscometrics, flash point, bioacceptability as well as favorable product economics.” While the Ashjian reference teaches various paraffin and olefin combinations and refers to hydrocarbon blends of paraffins and olefins throughout, the one-time appearance of the word “esters” in the context quoted above is not a teaching or anticipation of the blend of Applicants’ invention, namely isomerized olefins and paraffin hydrocarbons blended with esters. To further distinguish, Applicants have amended claim 24 to recite specific proportions of the blend components, namely, that the esters comprise at least about 46 weight percent and less than about 99 weight percent of the blend, the paraffin hydrocarbons comprise less than about 54 weight percent of the blend, and the isomerized olefins comprise less than about 54 weight percent of the blend. Applicants do not believe that

the Ashjian reference teaches any amount of esters that may be used with paraffin hydrocarbons blended with isomerized olefins and respectfully submit that only with improper hindsight, using Applicants' own teachings, can the ratios be obtained that the Examiner attributes to the Ashjian reference.

Applicants respectfully request that the Examiner withdraw his rejections based on the Ashjian reference. Applicants further respectfully request that the Examiner enter the amendments and allow the application to proceed to issue. In the event that a Request for Continued Examination is necessary for the Examiner to consider and enter Applicants' amendments, Applicants have submitted herewith a Request for that purpose.

Respectfully submitted,

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